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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/332,420 06/14/99 HAUBER

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EXAMINER

IM52/0813

JOHN F MCDEVITT
2255 PAR LANE #626
WILLOUGHBY HILLS OH 44094

CHEVALIER, A

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

08/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/332,420

Applicant(s)

HAUBER, DAVID EDGAR

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 11-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

RESPONSE TO AMENDMENT

1. Applicant's election with traverse of Group I, claims 1-10, in Paper No. 4 is acknowledged. The traversal is on the ground(s) that a product-by-process claim cannot be restricted from process and apparatus claims. This is not found persuasive.

A product-by-process claim is a product claim that defines the claimed product in terms of the process by which it is made, but determination of patentability is based on the final product and not on the method of production. Claims 1-10 are independent from the process and apparatus claims, claims 11-34, and are distinct because they are considered product claims defined structurally by the process limitations not evaluated by the process limitations.

There are only two criteria for proper requirement for restriction between patentably distinct inventions : (A) The inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner if restriction is required. As discussed above, claims 1-10 are distinct from claims 11-34 since they refer to a product claims and are evaluated solely on their structural limitations, even if defined by process limitations. The serious burden as has been shown by the different classification of the separate inventions and that the inventions have acquired a separate status in the art because of their recognized divergent subject matter. Therefore, the criteria for proper restriction has been met and is maintained.

The requirement is still deemed proper and is therefore made FINAL.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. §112 rejections of claims 1-10 of record in paper #3, pages 3-4, paragraph #7 have been withdrawn due to Applicant's amendment in paper #4.
3. The 35 U.S.C. §102 and §103 rejections of claims 1-10 as anticipated and over Abdullaev (4,431,034) of record in paper #3, pages 4-5 and 7, paragraphs #9 and #12 have been withdrawn.

REJECTIONS REPEATED

4. The 35 U.S.C. §102 and §103 rejections of claims 1-10 as anticipated and over Keister (4,343,333) are repeated for reasons previously of record in paper #3, pages 5-7, paragraphs #10 and #13.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments filed in paper #4 regarding the 35 U.S.C. §112 rejections of claims 1-10 of record have been considered but are moot since the rejections have been withdrawn.
6. Applicant's arguments filed in paper #4 regarding the 35 U.S.C. §102 and 103 rejections of claims 1-10 as anticipated and over Abdullaev (4,431,034) of record have been considered but are moot since the rejections have been withdrawn.
7. Applicant's arguments filed in paper #4 regarding the 35 U.S.C. §102 and 103 rejections of claims 1-10 as anticipated and over Keister (4,343,333) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the fiber reinforcement of Keister is bonded to the core tube in a different way than as claimed by Applicant and that Keister does not disclose a specific method

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to make their product. As stated above, a product-by-process claim is a product claim that defines the claimed product in terms of the process by which it is made, but determination of patentability is based on the product itself and not on the method of production. The lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps, which must be established. It has been held that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based on either section 102 or 103 is eminently fair and acceptable. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). Since Keister discloses a product, which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, except for the process, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art.

Applicant argues that the grounds of rejection under 103 are in error since the rejected claims, claims 7-10, require the pipe lengths to be joined together "at the ends" when being reinforced. This is a process limitation that is given little or no patentable weight. See above arguments regarding product-by-process claims. Therefore, it is irrelevant if the pipes are joined before or after the reinforcement process.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays


If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Blaine Copenheaver can be reached by dialing (703) 308-1261. The fax phone number for the organization official non-final papers is (703) 305-5436. The fax number for after final papers is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

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